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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/542,109	03/31/2000	Peter J. Kight	3350-31G	4187

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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/542,109

Applicant(s)

KIGHT ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-39, 42-47, 50-55, 58 and 59 is/are rejected.
- 7) ☒ Claim(s) 40, 41, 48, 49, 56 and 57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4&5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Preliminary amendments A, paper number 2 and B, paper number 3 received on 03/31/2000 are entered. Claims 1-35 have been cancelled. Currently claims 36-59 are pending for examination.

Claim Objections

2. Claims 40-41, 48-49, and 56-57 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of the parent claims 36, 44, and 52 are directed to receiving a routing number from the consumer of a financial institution and verifying it. With regards to claims 40, 48 and 56, which are dependencies of claims 36, 44 and 52 respectively, the limitations, "... receiving a request.....processing the received request.....can process electronic fund transfers " fail to further limit the claimed limitations of the parent claims 36, 44 and 52. Since claims 41, 49 and 57 are dependencies of claims 40, 48 and 56 respectively, they carry their said deficiency and are rejected. Note: Further examining of claims 40-41, 48-49, and 56-57 is kept pending till response from the applicant to this objection. Examiner suggests that claims 40, 48, and 56 could be independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 36-42, 44-50, and 52-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With reference to claims 36, 42, 44, 50, 52, and 58, the limitation of, "receiving from a consumer, via a network, a routing number maintains a deposit account", is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure teaches receiving a routing number of financial institution from a consumer via a voided check and not via a network (page 5, lines 7-10 and lines 16-17). Since claims 37-41, 45-49, and 53-57 are dependencies of claims 36, 44 and 52 respectively, they will inherit the same deficiencies as the independent claims and are therefore rejected under 35 U.S.C. 112, first paragraph. Note: In view of this 35 U.S.C. 112, first paragraph rejection and as taught in the disclosure, the limitation of receiving routing number of financial institution via paper (voided check) will be considered for further art rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 36-39, 43-47, 51-55, and 59 are rejected under 35 U.S.C. 102(e) as being anticipated by Tripp, Julie, ("How to Lend Uncle Sam your money PAGE: B1 ", The Oregonian; Portland, Or; Oct 28, 1990).

With regards to claims 36-39, Tripp discloses receiving from a consumer (s) a routing number(s) associated with a financial institution (s) at which the customer(s) maintains/maintain a deposit account(s) (Page 2, paragraph 4, "Fill out a one-page new account form including....bank routing number...you will get a direct payment into your bank account...").

Note: Federal Reserve Bank of San Francisco receives the routing numbers of the consumer's financial institution to execute electronic transfer of interest or returns, earned on principal, to their deposit accounts). Since there are number of users who buy Government Treasuries, it would be inherent that Federal Reserve Bank of San Francisco would receive plurality of routing numbers of a plurality of financial institutions from plurality of consumers and all these routing numbers have to be stored in a file/database/computer system correctly to be used recurrently for transferring the interest earned on the principal.

Tripp does not disclose verifying the routing numbers received from the consumers, if they are correct and further if the financial institution can process electronic fund transfers. Reason is that the 9th digit of the routing number is "self-check digit". If any one of the 8 digits is

incorrect the self-check 9th digit would flag the error, i.e., reject the routing number (For support of this inherency in the system, see enclosed excerpts " Routing symbol and Transit number ", page 109, Chapter 6-The Payment function by Francis et al., published by American Bankers Association in 1998, 1997, 1996, 1995, 1994, and 1998). Therefore verification of the routing number, received from the customer, is inherent in the system.

With regards to method claim 43, system claims 44-47, 51-55, and article of manufacture claim 59, their limitations correspond to the limitations of method claims 36-39 and are analyzed and rejected similarly, as above except for checking if financial institution can process electronic funds transfers. Also, checking if the financial institution can process electronic funds transfers is inherent in the system. The first four digits of the Routing numbers correspond to Federal Reserve Routing Symbol and the first two digits of these four digits indicate, if the banks can process electronic funds transfers (For support of this inherency in the system, see Page 11 of the pages 1-22 from the "Official Routing Number Registrar -Routing Number Policy formulated jointly by American Bankers Association and the Federal Reserve System in 1976, extracted from www.frp.com/aba.shtml, and copy of web page from www.aba.com with the heading, " ABA Routing Numbers" giving history and importance of the Routing numbers, total pages 2.).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 42, 50 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al. (US Patent 5220501) and further in view of Tripp.

With regards to claim 42, Lawlor teaches a method of receiving, via a network, a request to pay a bill associated with a merchant on behalf of a consumer, processing the received request to generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution can process electronic funds transfers (col.7, line 5-col.12, line 20. Note, col.7, lines 54-56, “.Payments not made electronically are sent by post....information list” indicate that the Lawlor system determines if the consumer financial institution can process electronic fund transfers and if not then it decides to use paper form that is check).

Lawlor further discloses use of “identification information account, destination bank, descriptor information...from database 84 files....for transmission to the customers bank through the ATM.....permit access to this account....debiting the amount of bill to be paid..” (Col.33, lines 28-37) implies to include a routing number of the user’s bank, as it is conventional to use a routing number in electronic funds transfer.

Lawlor explicitly fails to state receiving a routing number from the consumer of his financial institution and comparing it to a database of financial institution routing numbers to determine if the consumer financial institution can process electronic funds transfer.

However, Tripp discloses receiving from a consumer a routing number associated with a financial institution at which the customer maintains a deposit account and comparing it to a database of financial institution routing numbers to determine if the consumer financial institution can process electronic funds transfer. (Page 2, paragraph 4, “ Fill out a one-page new account form including....bank routing number...you will get a direct payment into your bank

account...". Note: Federal Reserve Bank of San Francisco receives the routing numbers of the consumer's financial institution to execute electronic transfer of interest or returns, earned on principal, to their deposit accounts). Since there are number of users who buy Government Treasuries, it would be inherent that Federal Reserve Bank of San Francisco would receive plurality of routing numbers of a plurality of financial institutions from plurality of consumers and all these routing numbers have to be stored in a file/database/computer system correctly to be used recurrently for transferring the interest earned on the principal. Further, determining from the routing number if the consumer financial institution can process electronic funds transfer is inherent in the system. The first four digits of the Routing numbers correspond to Federal Reserve Routing Symbol and the first two digits of these four digits indicate, if the banks can process electronic funds transfers (For support of this inherency in the system, see Page 11 of the pages 1-22 from the "Official Routing Number Registrar -Routing Number Policy formulated jointly by American Bankers Association and the Federal Reserve System in 1976).

In view of Tripp, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine the concept of receiving routing number. Doing so would result in electronic transfer of funds and elimination of use of paper checks as suggested by Tripp (page 2, paragraph 5, "...*With electronic transfer, you won't get a check in the mail.....direct payment.....record-keeping* ") and thereby reducing the processing work for the banks and cutting the cost of operation.

With regards to system claim 50 and article of manufacture claim 58, their limitations correspond to those of method claim 42 and are analyzed and rejected similarly.

Response to Arguments

8. Applicant's arguments filed in Preliminary amendment B, paper number 3, on 03/31/00 with regards to claims 36-59 have been fully considered but are not persuasive.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patents: 3,761,682 to Barnes et al. (col.3, line 59-col.4, line16), 3,833,885 to Gentile et al. (col.6, line 63-col.7, line 27), 3,949,364 to Clark et al. (col.4, lines 20-30), 4,758,714 to Carlson et al. (col.9, lines 24-55), 4,960,981 to Benton et al. (col.1, lines 6-13, col.3, lines 26-35, and col.5, lines 60-63), 4,974,878 to Josephson(col.2, lines 5-19, col.13, line 10, col.15, lines 33-37, and col.16, line 19-col.18, line 11), 5,237,159 to Stephens et al. (col.1, lines 15-38, and col.8, lines 1-24), 5,303,149 to Janigian (col.3, lines 50-56, col.4, line 44-col.5, line 7) disclose that bank routing number is essentially required, during debit and credit transactions to user's accounts, to know the identity of the bank where the user's deposit account exists.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the


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organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
July 19, 2002



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